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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) NAI1P445/00.174.01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on May 3, 2006 Signature _____	Application Number 09/785,240	Filed 02/20/2001
Typed or printed name Erica L. Farlow	First Named Inventor Matthew T. Hart	
	Art Unit 2145	Examiner Choudhury, A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.   41,429
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____ Signature
Kevin J. Zilka
_____ Typed or printed name

(408) 971-2573
_____ Telephone number

5/3/0 ... Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐   *Total of _____ forms are submitted.

REMARKS

The Examiner has rejected Claims 9-11, 21-23, 33-35 and 37-43 under 35 U.S.C. 103(a) as being unpatentable over Pollack et al. (U.S. Patent No. 6,546,390) in view of Dieterman (U.S. Patent No. 6,393,464). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, and specifically with respect to applicant's claimed "message forwarding logic operable to forward said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message" (see the same or similar, but not necessarily identical language in each of the independent claims), the Examiner has stated that Pollack "does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email," but that Dieterman, (Col. 5, lines 24-46) "discloses prompting an administrator for approval of a potentially unwanted e-mail message."

Applicant respectfully asserts that, in Dieterman, messages that require approval are placed in an inbox for an administrator to approve before being put in a user's inbox. Thus, since Dieterman only discloses administrator approval, Dieterman does not teach "forward[ing] said potentially unwanted e-mail message to its addressee together with a prompt for said **addressee** to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message," as applicant specifically claims (emphasis added).

In the Advisory mailed 03/23/2006, the Examiner, in response, argued "the Dieterman art teaches means for approval of potentially unwanted email (Dieterman, column 5, lines 24-46)." Applicant respectfully asserts that the excerpt from Dieterman relied upon by the Examiner discloses that "[a]n administrator thereafter may approve each such message, step 59" (emphasis added). Additionally, the administrator approval is further described in Figure 5, step 59 as an "[a]pproval by guardian" (emphasis added). However, "administrator

approval" and "[a]pproval by guardian" clearly fails to even suggest a technique where "message forwarding logic [is] operable to <u>forward said potentially unwanted e-mail message to its addressee together with a prompt</u> for <u>said addressee to provide feedback</u> as to whether or not said received e-mail message is an unwanted e-mail message" (emphasis added), as claimed by applicant.

Still with respect to each of the independent claims, the Examiner has relied on the following excerpt from Pollock to make a prior art showing of applicant's claimed technique "wherein a rule associated with said e-mail filtering logic is added if a threshold of a predetermined number of votes positively identifies said potentially unwanted e-mail message as an unwanted e-mail message" (see the same or similar, but not necessarily identical language in each of the independent claims).

> "The method may further include steps of developing message
> information based on the incoming message, the relevancy scores,
> and the profiles of the plurality of users to the plurality of
> users, and delivering the message information to at least some of
> the plurality of users. The user profiles database may include
> relevancy thresholds for the plurality of users, the step of
> developing the message information may include a step of
> comparing the relevancy scores to the relevancy thresholds; and
> the step of delivering the message information may include a step
> of delivering the message information only to those users whose
> relevancy scores satisfy the corresponding relevancy thresholds.
> The user profiles database may include a maximum number of users
> to whom the message information is to be delivered, and the step
> of delivering the message information may include a step of
> delivering the message information to no greater than the maximum
> number of users. The step of delivering the message information
> may include a step of sending the message information to the at
> least some of the plurality of users as an electronic mail
> message, or a step of updating a message display using the
> message information." (Col. 3, lines 51-60)

Applicant respectfully asserts that such excerpt does not even suggest any sort of "<u>threshold</u> of a predetermined number of votes," as applicant claims (emphasis added). In particular, Pollack only modifies a user's profile based on the <u>user's</u> feedback indicating either a positive or negative preference for the message information. Clearly, Pollack also fails to disclose <u>votes</u>, as applicant claims, but instead only discloses a user's feedback. Thus, Pollack only uses a single instance of a user's feedback in order to

modify the same <u>user's</u> profile, and therefore does not utilize a "threshold of a predetermined number of votes [that] positively identifies said potentially unwanted e-mail message as an unwanted e-mail message," as applicant claims.

In the Advisory mailed 03/23/2006, the Examiner, in response, argued that "Pollack teaches how feedback is permitted by the user (column 6, line 45 – column 7, line 3, Pollack)." Applicant respectfully asserts that the excerpt relied upon by the Examiner merely teaches that "the delivery mechanism 118 may then only <u>deliver the message information</u> 120 to users <u>whose relevancy scores satisfy their relevancy thresholds</u>" (emphasis added). However, "relevancy thresholds" simply fail to meet a technique where "<u>votes positively identifies</u> said potentially unwanted <u>e-mail message as an unwanted e-mail message</u>" (emphasis added), as claimed.

In addition, the Examiner argues that Pollack teaches that, "if a threshold is met, then a rule is applied (column 3, lines 51-60, Pollack)." Applicant respectfully asserts that the excerpt from Pollack relied upon by the Examiner teaches that "receiving <u>user feedback</u> may include ... receiving an indication from the user that the user has expressed a <u>positive preference</u>..." or "<u>negative preference</u> for the <u>message information</u>" (emphasis added). However, simply disclosing "user feedback" with a "positive preference" or "negative preference" simply fails to disclose "e-mail filtering logic [that] is added if a threshold of a predetermined number of votes," as claimed by applicant. Therefore, only applicant teaches a technique "wherein a rule associated with said e-mail filtering logic is added if a <u>threshold of a predetermined number of votes positively identifies said potentially unwanted e-mail message as an unwanted e-mail message</u>" (emphasis added), as claimed by applicant.

Applicant thus respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest <u>all</u> of the claim limitations, as noted above. A notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 10 et al., the Examiner has relied on Col. 6, lines 30-32 and Col. 9, line 60-Col. 10, line 19 in Pollock to make a prior art showing of applicant's claimed technique "wherein said potentially unwanted e-mail message is forwarded encapsulated within a markup language document including a hypertext markup language document capable of being displayed utilizing a network browser, the document providing voting buttons to allow said addressee to provide said feedback."

Applicant respectfully asserts that the excerpts relied on by the Examiner only disclose posting message information to a web page and "present[ing] a graphical display of the preference matrix 200 that is directly editable by the user." Clearly, only displaying a <u>preference matrix</u>, as in Pollock, does not even suggest that such preference matrix is displayed in association with the forwarding of the potentially unwanted e-mail message, in the context claimed by applicant. In particular, applicant specifically claims that "said potentially unwanted <u>e-mail message</u> is forwarded <u>encapsulated within a markup language document including a hypertext markup language document</u> capable of being <u>displayed</u> utilizing a network browser, the <u>document providing voting buttons</u> to allow said addressee to provide said feedback" (emphasis added).

In the Advisory mailed 03/23/2006, the Examiner, in response, argued that "the Pollack art allows for a web interface (column 6, lines 30-32, Pollack) and a voting interface (column 9, line 60 – column 10, line 19, Pollack)." Applicant asserts that the excerpt from Pollack relied upon by the Examiner merely teaches that "the delivery mechanism 118 may <u>post the message information 120 to a web page</u> accessible to the user 122" (emphasis added) which simply fails to meet a technique "wherein said potentially unwanted e-mail message is <u>forwarded encapsulated within a markup language document</u> including a hypertext markup language document capable of being displayed utilizing a network browser" (emphasis added), as claimed by applicant.

Additionally, the Examiner argues that the foregoing excerpt from Pollack discloses that "[t]he system 100 may present a <u>graphical display of the preference matrix</u> 200 that is directly editable by the user 122" (emphasis added). However, the "graphical display of the preference matrix" simply fails to meet a technique where "the document provid[es] <u>voting buttons to allow said **addressee** to provide said feedback</u>" (emphasis added), as claimed by applicant.

With respect to Claim 37, the Examiner has relied on Col. 6, lines 19-23 in Pollock to make a prior art showing of applicant's claimed technique "wherein said scoring algorithm is responsive to an addressee list of said received e-mail message." Specifically, the Examiner has stated that such excerpt in Pollock teaches that "a design allows filtering by many means including author." Applicant respectfully asserts that the excerpt relied on by the Examiner only teaches that the "message information 120 may include...the author of the incoming message." Thus, Pollock only discloses that message information that is sent to a recipient may include an author (i.e. <u>addressor</u>) of the associated message. Clearly, such teaching does not even suggest any sort of <u>scoring algorithm</u>, as applicant claims, and especially not where the "scoring algorithm is responsive to an <u>addressee</u> list of said received e-mail message," as claimed (emphasis added).

In the Advisory mailed 03/23/2006, the Examiner, in response, argued that 'the Pollack art again teaches how a user is able to provide feedback and that information is used towards "relevancy scores" (column 4, lines 2-3, Pollack).' Applicant respectfully asserts the excerpt relied upon by the Examiner teaches a "step of comparing the relevancy scores to the relevancy thresholds" which clearly fails to disclose a technique of a "<u>scoring algorithm</u> ... responsive to an <u>addressee list</u> of said received e-mail message" (emphasis added), as claimed by applicant.